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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,530	02/17/2006	Touru Niizaki	00331063PUS1	4991

2292 7590 10/19/2007
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EXAMINER	
ABU ALI, SHUANGYI	

ART UNIT	PAPER NUMBER
1793	

NOTIFICATION DATE	DELIVERY MODE
10/19/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/568,530	NIIZAKI, TOURU	
	Examiner	Art Unit	
	Shuangyi Abu-Ali	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 July 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5 and 8-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 8-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

(1)

Status of Claims

Claims 1-10 remain for examination wherein claims 4-5 are amended and claims 6-7 are canceled. Claims 11-15 are new.

(2)

Claim Rejections - 35 USC § 102

Claims 1-5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/17313 A1to Hulin et al. as general set forth in the first office action mailed on 03/07/2007 stands.

Claim Rejections - 35 USC § 103

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/17313 A1to Hulin et al., in view of U.S. Patent No. 5,270,445 to Hou, as general set forth in the first office action mailed 03/07/2007 stands.

The text of those sections of title 35 US Code not included in this action can be found in the prior Office Action.

(3)

Response to Amendment

Applicants' amendments to the 35 U. S. C. 112 rejections of claims 4 and 5, filed on 07/30/2007/2007 are acknowledged. As such, the rejection to the claims 4 and 5 set forth in the First Office Action are withdrawn.

(4)

Response to Arguments

Applicant's arguments filed 07/30/2007 have been fully considered but they are not persuasive. Therefore, the grounds of rejection for claims 1-10 as indicated in the first Office Action stand.

Regarding 35 U.S.C. 102 (b) rejection, first, the applicant argues that Hulin is drawn to solve a problem different from the instant application. The Examiner respectfully submits that both the instant application and Hulin are drawn to a composition. Hulin's composition comprise of carrier, resin and charge control agent. Furthermore, the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Arguments that the alleged anticipatory prior art is nonanalogous art' or teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, are not germane' to a rejection under section 102.

Second, the applicant argues that Hulin 's carrier surface is not coated with a resin film. The Examiner respectfully submits that the even if the resin composition is temporarily coated on the surface of the carrier; the composition would still be read on the limitation.

Third, the applicant argues that Hulin is silent about the charge value relationship. The Examiner agrees with the applicant. However, it is the position of the

examiner that since the charge value relationship is determined by the composition, and the charge value of resin and charge value agent themselves, which is a property of the resin and charge value agent, the claimed value difference would be inherent to of Hulin et al. See MPEP 2112.

Regarding 35 U. S. C. rejection, the applicant argues that the primary reference is not valid, therefore the 35 U.S.C. 103(a) should be withdrawn. The Examiner respectfully submits that since the primary reference is valid as set forth above, 35 U. S. C. 103(a) rejection stands

(4)

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "effective", " high", "excellent" in claim 15 are relative terms which renders the claim indefinite. The term "effective", " high", "excellent" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

(5)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-329226 to Yoshiki, in view of JP 56-141367 to Shizuo et al.

Regarding claims11-15, Yoshiki et al. disclose a composition comprising metal flake coated with a resin. The metal flake is selected from aluminum, and copper et al ([0016]). The flake particles have a diameter of 1-100 μm and a thickness of 0.01- 5 μm. But they are silent about the charge control agent used in the composition.

However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to charge control agent in the composition, motivated by the fact that Shizuo et al et al., also drawn to composition comprising of metal fake and a resin, disclose that fatty acid amide, which is a charge control agent, used in the composition can provide a composition with improved dispersion (abstract).

Although they are silent about the charge value relation between the carrier and resin as applicant set forth in claim 15, it is the position of the examiner that since the charge value difference is determined by the charge value of resin and charge value agent themselves, which is a property of the resin and charge value agent, the claimed value difference would be inherent to of co9mbined teaching of Yoshiki et al. and Shizuo et al. See MPEP 2112.

Regarding claim 14, Shizuo et al et al. disclose that the metallic powder amount is in the range of 0.5-50 parts. And the Fatty acid amide amount is in the range of 0.05-10 parts (abstract).

(6)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shuangyi Abu-Ali whose telephone number is 571-272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SA

J. A. LORENGO
SUPERVISORY PATENT EXAMINER